



Docket No.: 1614.1163

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Fujio MORITA

Serial No. 09/841,038

Group Art Unit: 2162

Confirmation No. 6609

Filed: April 25, 2001

Examiner: Jean B. Fleurantin

For: SEARCH SUPPORT DEVICE AND METHOD, AND RECORDING MEDIUM STORING
PROGRAM FOR COMPUTER TO CARRY OUT OPERATION WITH SAID SEARCH
SUPPORT DEVICE

PRE-APPEAL BRIEF CONFERENCE REQUEST

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application.

Applicant respectfully notes that in the Office Action Summary page of the Office Action mailed on August 10, 2006, the "Disposition of Claims" section indicates the claims as being objected to, but the arguments starting page 2 clearly show that the claims were in fact rejected. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the following reasons:

I. THE REJECTIONS ARE CLEARLY WITHOUT BASIS AS THE OFFICE ACTIONS IGNORE EXPRESS CLAIM ELEMENTS

In Office Actions dated January 12, 2006, and August 10, 2006, claims 1-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over the "Related Art" section of the specification in view of the Japanese Patent No. 10031683A to Haruhiro ("Haruhiro"). The rejection of claim 1 is illustrative as to how the Office Actions ignore express claim elements, such as, for example, the search unit.

claims, does not respond to previously filed arguments and in so doing, is clearly without basis.

II. THE REJECTIONS OMIT ESSENTIAL ELEMENTS REQUIRED TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS

The rejection of claim 1, which is an exemplary illustration of the rejections of the independent claims, fails to provide a valid motivation to combine the teachings of the Related Art and Haruhiro. As an alleged motivation, for example, on page 3 of the Office Action mailed on August 10, 2006, it is stated:

Such a modification [with the search device of Haruhiro] would allow the teachings of Related Art to provide a retrieval system, which efficiently retrieving the URL information of a lot of World Wide Web servers connected to a W W W (see Haruhiro abstract).

Applicants respectfully submit that this rather conclusory assertion is clearly insufficient to establish a prima facie case of obviousness. In other words, Applicants respectfully submit that the rejection amounts to an improper hindsight reconstruction because the device of Haruhiro was already achieving the goals stated in the Abstract.

CONCLUSION

Accordingly, the Applicants respectfully submit that the Examiner's rejections are clearly without basis and should be withdrawn. Further, the Applicants respectfully request that the Office issue a finding that the application is allowed on the existing claims and that prosecution remains closed.

Respectfully submitted,

STAAS & HALSEY LLP

Date: Nov. 13, 2006

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